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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,923	11/24/2003	Roger Bruce Harding	01313/100F022-US3	1897
7278	7590	04/18/2007		
DARBY & DARBY P.C. P. O. BOX 5257 NEW YORK, NY 10150-5257			EXAMINER WHITE, EVERETT NMN	
			ART UNIT	PAPER NUMBER
			1623	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/18/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/722,923

Applicant(s)

HARDING ET AL.

Examiner

Everett White

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. -See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-50 and 55-73 is/are pending in the application.
- 4a) Of the above claim(s) 3, 6, 8, 44, 45, 47-50, 55-70 and 72 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5, 7, 9-43, 46 and 71 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. The amendment filed February 1, 2007 has been received, entered and carefully considered. The amendment affects the instant application accordingly:
  - (A) Comments regarding Office Action have been provided drawn to:
    - (I) 112, 2<sup>nd</sup> paragraph rejections, which have been withdrawn;
    - (II) 102(b) rejection, which has been maintained for the reasons of record;
    - (II) 103(a) rejection, which has been maintained for the reasons of record.
2. Claims 1-50 and 55-73 are pending in the case; Claims 47-50 and 55-70 are withdrawn from consideration as being drawn to non-elected inventions.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 10, 11, 14-19, 35-43, 46 and 71 stand rejected under 35 U.S.C. 102(b) as being anticipated by Ohnaka et al (US Patent No. 4,063,018) for the reasons disclosed on pages 3 and 4 of the Office Action filed November 1, 2006.
5. Applicant's arguments filed February 1, 2007 have been fully considered but they are not persuasive. Applicants argue against the rejection on the ground that the instantly claimed method involves use of a mercerizing agent twice and set forth a chart of the present process showing two mercerization steps. This argument is not persuasive since instant Claim 1, for example, does not disclose more than one mercerization step. Accordingly, the rejection of Claims 1, 10, 11, 14-19, 35-43, 46 and 71 under 35 U.S.C. 102(b) as being anticipated by Ohnaka et al patent is maintained for the reasons of record.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 2, 4, 5, 7, 9, 12, 13 and 20-34 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ohnaka et al (US Patent No. 4,063,018) in view of Mansikkamaki et al (EP 879,827 A2) for the reasons disclosed on pages 5 and 6 of the Office Action filed November 1, 2006.

8. Applicant's arguments filed February 2, 2007 have been fully considered but they are not persuasive. Applicants argue against the rejection on the ground that the Ohnaka et al and Mansikkamaki et al references do not disclose recovering cellulose pulp as instantly claimed. Applicants state, but not claimed, that recovery involves

removal or neutralization of most or all of the mercerizing agent. This argument is not persuasive since the claims do not disclose the "removal or neutralization of most or all of the mercerizing agent". In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "removal or neutralization of most or all of the mercerizing agent") is not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Accordingly, the rejection of Claims 2, 4, 5, 7, 9, 12, 13 and 20-34 under 35 U.S.C. 103(a) as being unpatentable over the Ohnaka et al patent in view of Mansikkamaki et al EP patent is maintained for the reasons of record.

9. Claims 3, 6, 8, 44, 45, 72 and 73 are withdrawn from consideration since these claims are drawn to cellulose ethers and cellulose pulp other than carboxymethyl-cellulose and sulfite pulp, which are the elected species selected by Applicants due to the Election of Species requirement.

10. Claims 47-50 and 55-70 are drawn to non-elected inventions and are withdrawn from consideration.

### **Summary**

11. Claims 1, 2, 4, 5, 7, 9-43, 46 and 71 are rejected; Claims 3, 6, 8, 44, 45, 72 and 73 are withdrawn from consideration due to being drawn to non-elected species; Claims 47-50 and 55-70 are withdrawn from consideration due to being non-elected inventions; and Claims 51-54 were previously canceled.

12. This application contains Claims 3, 6, 8, 44, 45, 47-50, 55-70 and 72 drawn to an invention nonelected with traverse in the Applicants Response filed August 14, 2006. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

**Conclusion**

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Examiner's Telephone Number, Fax Number, and Other Information***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Everett White whose telephone number is 571-272-0660. The examiner can normally be reached on 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia A. Jiang can be reached on 571-272-066127. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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